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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,215

06/09/2005

Warner Rudolph Theophile Ten Kate

NL 021375

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03/06/2007

PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

TSUI, WILSON W

ART UNIT

PAPER NUMBER

2178

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/06/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/538,215

Applicant(s)

TEN KATE ET AL.

Examiner

Wilson Tsui

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

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**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20050609
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to the application filed on: 6/9/2005, and IDS filed on: 6/9/2005.

2. Claims 1-10 are pending. Claims 1, 6, 8, 9, and 10 are independent claims.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. With regards to claim 8, it is unclear as to how the claimed "media player", which comprises the limitations of claim 6, is mean to distinguish the media player from the system of claim 6.

5. With regards to claim 9, which includes the limitation of "the media player" in claim 8, is rejected under similar rationale.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 3, 6 - 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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With regards to claim 8, the claimed "media player" appears to be directed to a "computer program per se". Since the computer program is not embodied in a computer readable medium, it is thus, not statutory. See MPEP 2105 below:

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held non statutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and thus statutory.

7. With regards to claims 3, 7, and 9, the claimed "Information carrier", appears to be a carrier wave. Because carrier waves, being a form of electromagnetic energy, do not fall into one of the statutory categories of 35 U.S.C. 101, the claim includes non-statutory subject matter. A detailed explanation describing why carrier waves are regarded as non-statutory subject matter under 35 U.S.C. 101 follows:

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, *per se*, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.

First, a claimed signal is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material.

"The term machine includes every mechanical device or combination of mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result." Corning v. Burden, 56 U.S. (15 How.) 252, 267 (1854). A modern definition of machine would no doubt include electronic devices which

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perform functions. Indeed, devices such as flip-flops and computers are referred to in computer science as sequential machines. A claimed signal has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine.

A "composition of matter" "covers all compositions of two or more substances and includes all composite articles, whether they be results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids." *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff'd*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958). A claimed signal is not matter, but a form of energy, and therefore is not a composition of matter.

The Supreme Court has read the term "manufacture" in accordance with its dictionary definition to mean "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery." *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11, 8 USPQ 131, 133 (1931), which, in turn, quotes the *Century Dictionary*). Other courts have applied similar definitions. See *American Disappearing Bed Co. v. Arnaelsteen*, 182 F. 324, 325 (9th Cir. 1910), *cert. denied*, 220 U.S. 622 (1911). These definitions require physical substance, which a claimed signal does not have. Congress can be presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change. *Lorillard v. Pons*, 434 U.S. 575, 580 (1978). Thus, Congress must be presumed to have been aware of the interpretation of manufacture in *American Fruit Growers* when it passed the 1952 Patent Act.

A manufacture is also defined as the residual class of product. 1 Chisum, § 1.02[3] (citing W. Robinson, *The Law of Patents for Useful Inventions* 270 (1890)).

A product is a tangible physical article or object, some form of matter, which a signal is not. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of § 101.

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8. With regards to claim 6, the claimed "system" appears to be a computer program per se without hardware. Thus, since the computer program is not embodied in a computer readable medium, it is thus not statutory.

9. With regards to claim 7, which depends on claim 6, and failing to remedy the issues of claim 6, is rejected under similar rationale.

10. With regards to claim 10, the claimed "computer program product" appears to be a computer program per se. Since the computer program is not embodied in a computer readable medium, it is thus not statutory.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 3, 5, 6, 8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Himmel et al (US Patent: 6,208,995 B1, issued: Mar. 27, 2001, filed: Nov. 24, 1997).

With regards to claim 1, Himmel et al teaches a method comprising:

*Requesting by the user for the document to be presented (column 7, lines 40-50:*

*whereas, a user requests a home web page, by activating a bookmark set)*

*Determining if the document is present within a sub-collection of the collection, the sub-collection comprising those documents, of the collection of documents, that are allowed*

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*to be presented to the user* (column 9, lines 30-55: whereas, a document is checked to determine if it is within a subcollection/set of a collection of bookmark sets)

*Presenting the document to the user if the document is present within the sub-collection* (column 9, lines 30-55: whereas, the document is presented to the user if the document is within the subcollection/set)

With regards to claim 2, which depends on claim 1, Himmel et al teaches *reading the sub-collection from a location* (column 13, lines 26-60: whereas, a subcollection/set, is retrieved/read from an internet web site.)

With regards to claim 3, which depends on claim 2, Himmel et al teaches *wherein the location is one of an internet site*, as similarly explained in the rejection for claim 2, and is rejected under similar rationale.

With regards to claim 5, which depends on claim 2, Himmel et al teaches *wherein the location comprises a reference to the sub-collection* (column 13, lines 50-60: whereas, a hyperlink is the reference to the sub-collection/set).

With regards to claim 6, for a system performing a method that is similar to the method of claim 1, is rejected under similar rationale.

With regards to claim 8. for a *Media player comprising the system according to claim 6*, is rejected under similar rationale as claim 6 (since the system of claim 6 “plays” internet document media).

With regards to claim 10. for a *computer program product designed to perform the method according to claim 1*, is rejected under similar rationale as claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 4, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Himmel et al (US Patent: 6,208,995 B1, issued: Mar. 27, 2001, filed: Nov. 24, 1997), in further view of Metz et al (US Patent: 5,768,539, issued: Jun. 16, 1998, filed: Dec. 17, 1996)

With regards to claim 4, which depends on claim 2, Himmel et al teaches:

Reading/retrieving a document *from the location; and continuing reading/retrieving a document if the document that the user requested is present within the sub-collection comprising those documents that are allowed to be presented to the user* (column 9, lines 30-55).

However, Himmel et al does not expressly teach that the document is an *interactive presentation*.

Metz et al teaches a document/data file is an *interactive presentation* (column 10, lines 45-51: whereas a data file is an interactive presentation).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Himmel et al's method for restricting access to particular documents/files, such that interactive presentations are restricted as well, as taught by Metz et al. The combination of Himmel et al and Metz et al would have allowed Himmel



et al to have “dynamically downloaded applications program software” (column 1, lines 21-22).

With regards to claim 7, which depends on claim 6, Himmel et al teaches: *reading means conceived to read the sub-collection from an information carrier*, as similarly explained in the rejection for claim 2.

Additionally, as explained in the rejection for claim 4, Himmel et al and Metz similarly teach *playing means conceived to continue playing an interactive presentation if the document, that the user requested, is present within the sub-collection comprising those documents that are allowed to be presented to the user*.

With regards to claim 9. *Information carrier for use in the media player according to claim 8*, (as similarly explained in the rejection for claim 6, and is rejected under the same rationale) *the information carrier comprising an interactive presentation and a sub-collection comprising those documents that are allowed to be presented to a user* (as similarly explained in the rejection for claim 4).

### **Conclusion**

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Massarani (US Patent: 6,336,117 B1): This reference teaches a subcollection of documents for each user ID.
- Dougu (US Patent: 6,928,455 B2): This reference teaches a subcollection of documents, that are allowed to be presented to the user, and the subcollection of documents are retrieved from a location.

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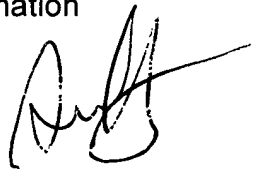
- Fishman et al (US Patent: 7,117,266 B2): This reference teaches a filtering method for web pages, by implementing a walled garden technique.
- Cirasole et al (US Patent: 5,987,606): This reference teaches black listing and white listing web pages.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wilson Tsui whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

W. T. 3/2/07  
Wilson Tsui  
Patent Examiner  
Art Unit: 2178  
March 2, 2007

  
STEPHEN HONG  
SUPERVISORY PATENT EXAMINER